REMARKS

The Office Action dated April 24, 2006 has been received and carefully noted. The above amendments to the claims and the following remarks are submitted as a full and complete response thereto.

Claims 1-9 are amended to more particularly point out and distinctly claim the subject matter of the present invention. New claims 10 and 11 are added. No new matter is added. Claims 1-11 are respectfully submitted for consideration.

The Office Action rejected claim 6 under 35 U.S.C. 112, second paragraph for being indefinite. Applicants submit that claim 6 is amended to particularly point out and distinctly claim the subject matter of the invention. Accordingly, withdrawal of the rejection under 35 U.S.C. 112, second paragraph is respectfully requested.

The Office Action rejected claims 1-3, 5 and 7-9 under 35 U.S.C. 1029e) as being anticipated by PCT/FI97/00020 to Kari et al. (Kari). Applicants respectfully submit that Kari fails to disclose or suggest all of the features of any of the pending claims.

Claim 1, from which claims 2-6 depend, is directed to a method of paging a mobile station to establish a packet-switched connection in a mobile telephone network. sending from the mobile telephone network to the mobile station sends a page request to establish a mobile-terminated circuit-switched connection. In response to the page request, the mobile station switches to standby mode for a circuit-switched connection.

The mobile station listens only to the paging channels of the circuit-switched connection. To establish a mobile-terminated packet-switched connection, the mobile telephone network sends the mobile station a page request via the circuit-switched connection and sends the mobile station additional information commanding it to switch to a packet-switched connection. In response to the additional information, the mobile station switches to the packet-switched connection. The mobile telephone network supports the circuit-switched connection and the packet-switched connection.

Claim 7 is directed to an arrangement for paging a mobile station to establish a packet-switched connection. A mobile telephone network is configured to send a mobile station a page request to establish a mobile-terminated circuit-switched connection. In response to said page request, the mobile station is configured to switch to standby mode for a circuit-switched connection. To establish a mobile-terminated packet-switched connection, the mobile station is configured to listen to paging channels only on the circuit-switched connection. The mobile telephone network is configured to send the mobile station a page request via the circuit-switched connection and to send the additional information to the mobile station. The mobile station is configured to switch to a packet-switched connection in response to said additional information. The mobile station establishes the packet-switched connection in the mobile telephone network that supports the circuit-switched connection and the packet-switched connection.

Claim 8 is directed to a mobile telephone network that supports a circuit-switched connection and a packet-switched connection. The mobile station sends a page request

via the circuit-switched connection to establish the mobile-terminated packet-switched connection. The mobile station receives the additional information to switch the mobile station to the packet-switched connection. The mobile telephone network is configured to send the mobile station the page request to establish a mobile-terminated circuit-switched connection.

Claim 9 is directed to a mobile station that supports a circuit-switched connection and a packet-switched connection. The mobile station listens only to a paging channel of the circuit-switched connection. Additional information sent on said circuit-switched connection is monitored. The packet-switched connection is switched to in response to said additional information. The paging channel is configured to page the mobile station associated at least with the circuit-switched connection.

Applicants respectfully submit that each of the pending claims recite features that are neither disclosed nor suggested in Kari.

Kari is directed to a radio interface that is provided in packet radio system (SGSN, GGSN, 10) by means of a digital mobile communication network (BTS, BSC, MSC, HLR). A dual-mode terminal equipment (MS) is capable of operating both in the mobile state and in the packet radio state but it monitors different control channels in these states. There is information in the subscriber database (HLR) of the mobile communication network that the mobile station (MS) is not available when it is in the packet radio state. This enables call forwarding and appropriate announcements in connection with mobile-terminating calls. There may also be information in the subscriber database (HLR) that

the mobile station is in the packet radio state. In that case the subscriber database (HLR) of the mobile communication network may send a notification to the mobile station (MS) via the packet radio network (SGSN, GGSN, 10) that the mobile station should transit to the mobile state for receiving an incoming call.

Applicants respectfully submit that Kari fails to disclose or suggest at least the feature of in response to said page request, the mobile station switches to standby mode for a circuit-switched connection, as recited in claim 1 and similarly recited in claim 7. The feature of a "standby mode" as clearly recited in claims 1 and 7, is neither disclosed nor suggested in Kari, or even acknowledged in the Office Action.

Further, Applicants respectfully submit that Kari fails to disclose or suggest the feature of a mobile station listening only to the paging channels of the circuit switched connection, as recited in claim 1 and similarly recited in claim 7. Kari merely discloses first control channels, which are allocated to the use of the mobile communication network in base station systems, second control channels which are allocated to the use of the packet radio network in base station systems, (and) a mobile terminal equipment having a first operating state where it monitors said first control channels and a second operating state where it monitors said second control channels. See page 3 line 24 – page 4 line 32 of Kari. Kari also states: "In one embodiment of the invention, the mobile station itself when transiting to the packet radio state, signals to the mobile communication network that it is not available for conventional mobile communication services." See page 6 line 33 -page 7 line 2 of Kari. Thus, Kari at best, merely discloses

that the mobile communication network knows unambiguously that the mobile station is not available for normal calls. See page 7 lines 21-23 of Kari. Kari clearly discloses that the mobile station must listen to (be available via) the paging channels of the packet-switched connection because it is not available to "normal" calls (i.e., circuit-switched in the context of Kari).

Still further, Applicants respectfully submit that Kari fails to disclose or suggest at all of the features of claims 1 and 7-9. As discussed above, according to the pending claims of the present invention the mobile station only listens to the circuit-switched paging channel, and when it detects a page signal therein, and additional information, it changes modes to packet-switched connection. Kari discloses a different problem and solution. Kari discloses that if the MS is in packet radio mode, the GSM paging channels are not being monitored. In that case, the MS may be informed that a circuit-switched mobile-terminated call is pending. This is opposite of the claims recited in the present application because the roles of the circuit-switched and packet-switched connections are interchanged. Therefore, Kari fails to disclose or suggest all of the features recited in claims 1, and 7-9.

Applicants respectfully submit that because claims 2, 3 and 5 depend from claim 1, these claims are allowable at least for the same reasons as claim 1, as well as for the additional features recited in these dependent claims.

Based at least on the above, Applicants respectfully submit that Kari fails to disclose or suggest all of the features recited in claims 1-3, 5 and 7-9. Accordingly, withdrawal of the rejection under 35 U.S.C. 102(e) is respectfully requested.

The Office Action rejected claims 4 and 6 under 35 U.S.C. 103(a) as being obvious over Kari. The Office Action took the position that Kari fails to disclose using SMS or a FACCH or SACCH channel. However, the Office Action took Official Notice that these features are well-known in the art as a paging technique in GSM systems. Applicants respectfully submit that Kari fails to disclose or suggest all of the features of claims 4 and 6. Specifically, Kari is deficient at least for the same reasons discussed above regarding claim 1.

Further, the Official Notice taken in the Office Action is respectfully traversed. The Office Action asserted that claim 6 of the present application somehow admits that these features are well-known in the art. However, Applicants respectfully submit that the Office Action is mischaracterizing the features recited in claim 6 as a result of improper hindsight, and that the present invention does not make such an admission. Thus, Applicants respectfully request evidence that the features recited in claims 4 and 6 are in fact, well-known in the art where applied to the features recited in claim 1. Accordingly, the Official Notice taken in the Office Action is respectfully traversed.

Based at least on the above, Applicants respectfully submit that Kari and the Official Notice taken in the Office Action, fail to disclose or suggest all of the features

recited in claims 4 and 6. Accordingly, withdrawal of the rejection under 35 U.S.C. 103(a) is respectfully requested.

As stated above, new claims 10 and 11 are added. Applicants respectfully submit that claims 10 and 11 recite features that are neither disclosed nor suggested in the cited reference.

Applicants respectfully submit that each of claims 1-11 recite features that are neither disclosed nor suggested in Kari. Accordingly, it is respectfully requested that each of claims 1-11 be allowed, and this application passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

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Enclosures: Petition for Extension of Time
Additional Claim Fee Transmittal
Check No. 15273